

REMARKS

Claims 2-7, 9, 13 and 14 are pending. No new matter has been added by way of the above amendments. For instance, the claims have simply been amended so that they now relate to at least one basic compound represented by the general formula (3). Also, a period has been added to the end of Claim 13. Thus, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Provisional Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-5 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-9 of co-pending Application No. 10/679,367 (published as U.S. 2005/0095527A1). Applicants respectfully traverse.

Applicants respectfully submit that this obviousness-type double patenting rejection is improper. Applicants draw the Examiner's attention to the fact that the present application is assigned to Shin-Etsu Chemical Co., Ltd., while Application No. 10/679,367 is assigned to JSP. Further, there are no overlapping inventors. Obviousness-type double patenting relates to a rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a "**commonly owned**" patent, when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. MPEP §804(B)(1). In the present instance, the Examiner cannot make a double patenting

rejection, when there are no common inventors and the applied reference and the application at issue are not commonly owned.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Issues under 35 U.S.C. §112, second paragraph

The Examiner has rejected claim 2 under 35 U.S.C. §112, second paragraph for the reasons recited at page 5 of the outstanding Office Action. Applicants respectfully traverse. The Examiner has asserted that claim 2 fails to specifically define R¹³ in formula (6). Applicants submit that formula (6) has been removed from claim 2. However, this rejection was improper even without the present amendments since R¹³ was already defined in claim 2, line 9 (counting the formulas as two lines). Reconsideration and withdrawal of this rejection are therefore respectfully requested.

Issues under 35 U.S.C. §102(e)

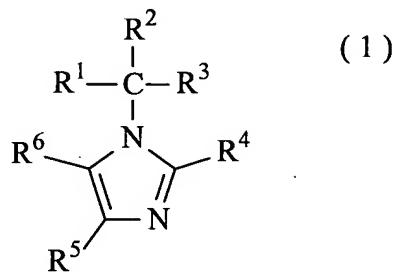
The Examiner has rejected claims 1-5 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication 2005/0095527A1 (hereinafter referred to as U.S. '527). Applicants respectfully traverse.

U.S. '527 discloses a positive tone radiation-sensitive resin composition comprising:

- (A) compound shown by the following formula (1),
- (B) a photoacid generator, and
- (C) the following component (C-a) or (C-b),

(C-a) a resin protected by an acid-dissociable group, insoluble or scarcely soluble in alkali, but becoming soluble in alkali when the acid-dissociable group dissociates
or

(C-b) an alkali-soluble resin and an alkali solubility controller;



wherein R¹, R², R³, R⁴, R⁵, and R⁶ individually represent a hydrogen atom, cyano group, substituted or unsubstituted alkyl group having 1-20 carbon atoms, substituted or unsubstituted alicyclic group having 3-20 carbon atoms, substituted or unsubstituted alkenyl group having 2-20 carbon atoms, substituted or unsubstituted aryl group, or substituted or unsubstituted heteroaryl group, provided that any two groups selected from R¹, R², R³, R⁴, R⁵, and R⁶ may be bonded together to form a ring which may comprise a hetero atom or may bond together to form a dimer.

In U.S. '527, the substituted hydrocarbon groups are discussed in [0046] as follows:

The above hydrocarbon groups may be substituted. Given as the substituents are a hydroxyl group; a carboxyl group; a hydroxyalkyl group having 1-4 carbon atoms such as a hydroxymethyl group, 1-hydroxyethyl group, 2-hydroxyethyl group, 1-hydroxypxopyl group,

2-hydroxypropyl group, 3-hydroxypropyl group, 1-hydroxybutyl group, 2-hydroxybutyl group, 3-hydroxybutyl group, and 4-hydroxybutyl group; an alkoxy group having 1-4 carbon atoms such as a methoxy group, ethoxy group, n-propoxy group, i-propoxy group, n-butoxy group, 2-methylpropoxy group, 1-methylpropoxy group, and t-butoxy group; a cyano group; a cyanoalkyl group having 2-5 carbon atoms such as a cyanomethyl group, 2-cyanoethyl group, 3-cyanopropyl group, and 4-cyanobutyl group; an alkoxycarbonyl group such as a methoxycarbonyl group, ethoxycarbonyl group, and t-butoxycarbonyl group; an alkoxycarbonylalkoxy group such as a methoxycarbonylmethoxy group, ethoxycarbonylmethoxy group, and t-butoxycarbonylmethoxy group; a halogen atom such as fluorine and chlorine; and a fluoroalkyl group such as a fluoxomethyl group, trifluoromethyl group, and pentafluoroethyl group.

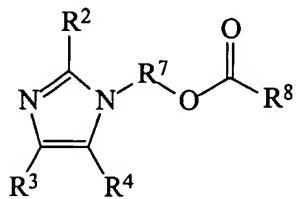
Further, U.S. '527 only discloses the following examples as shown in [00501]:

The following compounds can be given as specific examples of compound (A):

1-methylimidazole, 1-ethylimidazole, 1-hexylimidazole, 1-nonylimidazole, 1-1-butyylimidazole, 1-t-butyylimidazole, 1-cyclopentylimidazole, 1-cyclohexylimidazole, 1-phenylimidazole, 1-benzylimidazole, 1-naphtylimidazole, 1-anthrylimidazole, 1-norbornylimidazole, 1-adamantylimidazole, 1-vinylimidazole, 1-(2'-hydroxyethyl)imidazole, 1-(3'-hydroxy-n-butyl)imidazole, 1-methoxyimidazole, 1-(2'-methyl-n-propoxy)imidazole, 1-cyanoimidazole, 1-(2'-cyanomethyl)imidazole, 1-methoxycarbonylimidazole, 1-ethoxyarboxylethoxyimidazole, 1-trifluoromethylimidazole, 1, 2-dimethylimidazole, 1,2,4-trimethylimidazole, 1,2,4,5-tetramethylimidazole, 1-ethyl-2-methylimidazole, 1-butyl-2-methylimidazole, 1,2-dihexylimidazole, 1-ethyl-2-cyclohexylimidazole,

1,2-dicyclopentylimidazole, 1, 2, 4, 5-tetracyclopentylimidazole, 1-benzyl-2-methylimidazole, 1,2-dinaphthylimidazole, 1, 2-dinorbornylimidazole, 1,2,4-triadamantylimidazole, 1,2,4,5-tetraethoxycarbonylimidazole, 1-cyano-2-methylimidazole, 1-ethyl-2-methoxyimidazole, 1-(t-butoxycarbonylmethyl)imidazole, 1-(2',3'-dihydroxypropyl)-2-methylimidazole, and 1, 3-di(2'-methyl-1'-imidazoylmethyl)benzene. Of these, particularly preferable imidazoles are 1-methylimidazole, 1,2-dimethylimidazole, 1,2,4-trimethylimidazole, 1, 2, 4, 5-tetramethylimidazole, 1-ethylimidazole, 1-ethyl-2-methylimidazole, 1-butyl-2-methylimidazole, 1-benzylimidazole, 1-benzyl-2-methylimidazole, 1-(t-butoxycarbonylmethyl)imidazole, 1-(2',3'-dihydroxypropyl)-2-methylimidazole, and 1,3-di(2'-methyl-1'-imidazoylmethyl)benzene.

In contrast, the present invention relates to a resist composition comprising at least one basic compound represented by the general formula (3):



(3)

wherein R², R³ and R⁴ are each independently a hydrogen atom, a straight, branched or cyclic alkyl group of 1 to 10 carbon atoms, an aryl group of 6 to 10 carbon atoms, or an aralkyl group of 7 to 10 carbon atoms; R⁷ is a straight, branched or cyclic alkylene group of 1 to 10

carbon atoms; and R⁸ is a hydrogen atom or an alkyl group of 1 to 15 carbon atoms which may contain at least one group selected from among hydroxyl, carbonyl, ester, ether, sulfide, carbonate, cyano and acetal groups.

Accordingly, Applicants respectfully submit that there is no anticipation based upon U.S. '527. The Examiner is therefore respectfully requested to withdraw this rejection.

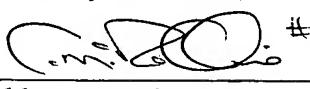
In view of the above, Applicants respectfully submit that the present claims are in condition for allowance. The Examiner is therefore respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: December 15, 2005

Respectfully submitted,

By  #42,874

Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant